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10/019,326	12/21/2001	Ulrich Brill	29462-032	4000

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11/10/2003

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EXAMINER

SHEEHAN, JOHN P

ART UNIT

PAPER NUMBER

1742

DATE MAILED: 11/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/019,326

Applicant(s)

BRILL ET AL.

Examiner

John P. Sheehan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 August 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-8 and 13-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-8 and 13-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 6 to 8 and 13 to 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

I. In claim 13, the penultimate line, the meaning of the phrase, "Nb and Ta as needed" is not clear. For example, "as needed" for what purpose? Without knowing the purpose for the Nb and Ta it is impossible to determine if these elements are needed. Further, this language is inconsistent with line 12 of claim 13 in that line 12 requires the presence of Nb whereas the phrase, "Nb and Ta as needed" means that Nb is optional. Thus, it is not clear whether the claims require Nb or whether Nb is optional.

II. The language, "the total of Nb and Ta is at most 0.30%" (claim 13, penultimate and last line) limits the Nb content to at most 0.30%, however line 12 of claim 13 recites "a content of 0.05-0.5% Nb", that is, an upper Nb limit of 0.5%. In view of this, the limitation, "a content of 0.05-0.5% Nb", (line 12) and the phrase, "the total of Nb and Ta is at most 0.30%" (penultimate and last line of

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claim 13) are inconsistent and render the claims indefinite as to the upper Nb content limit.

III. In like manner, the language, "the maximum total of Al + Ti is 0.30%" (claim 13, the last line) limits the Al content to at most 0.30%, however line 15 of claim 13 recites "a content of 0.05-0.5% Al", that is, an upper Al limit of 0.5%. In view of this, the limitation, "a content of 0.05-0.5% Al", (line 15) and the phrase, "the maximum total of Al + Ti is 0.30%" (claim 13, the last line) are inconsistent and render the claims indefinite as to the upper Al content limit.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 6 to 8 and 13 to 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kudo et al. (Kudo, US Patent No. 4,400,211, cited in the IDS submitted December 21, 2001).

Kudo teaches a nickel base alloy having a composition containing elements recited in applicants' claims in proportions that overlap the proportions recited in applicants' (see Kudo, column 3, line 63 to column 4, line 7). Kudo further teaches that the disclosed alloy may contain at least one of Nb, Ti, Ta, Zr and V in a total amount of

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0.5 to 4.0% (column 4, lines 10 to 12) and up to 0.5% Al (column 5, lines 42 to 44).

These elements and proportions overlap the instant claims.

Kudo and the claims differ in that Kudo does not teach the exact same proportions as recited in applicants' claims.

However, one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the alloy proportions taught by Kudo overlap the instantly claimed proportions and therefore are considered to establish a prima facie case of obviousness, in that it would have been obvious to one of ordinary skill in the art to select any portion of the disclosed range including the instantly claimed range, from the range disclosed in the prior art reference, In re Peterson 65 USPQ2d 1379 (CAFC 2003, In re Geisler 43 USPQ2d 1365 (Fed. Cir. 1997); In re Woodruff, 16 USPQ2d 1934 (CCPA 1976); In re Malagari, 182 USPQ 549, 553 (CCPA 1974) and MPEP 2144.05.

Response to Arguments

5. Applicant's arguments filed August 26, 2003 have been fully considered but they are not persuasive.

Applicants' arguments are based entirely on alleged differences between Kudo's claims and Kudo's example alloys and applicants' claims. These arguments are not persuasive. By basing their arguments only on Kudo's claims and example alloys and not on the entire Kudo patent applicants have not considered the Kudo reference in its entirety. However, the teachings of a reference encompass all that is taught in a

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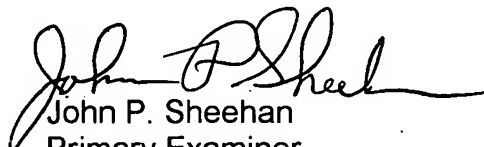
complete reading of the reference, MPEP 2123. As set forth in the statement of the rejection a complete reading of Kudo teaches alloy compositions that overlap the instantly claimed alloys.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Sheehan whose telephone number is (703) 308-3861. The examiner can normally be reached on T-F (6:30-5:00) Second Monday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (703) 308-1146. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.


John P. Sheehan
Primary Examiner
Art Unit 1742

jps
November 5, 2003